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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P1598US01	
I hereby certify that, on the date shown below, this correspondence is being facsimile transmitted to the Patent and Trademark Office, (571) 273-8300. 37 CFR §1.8(a) on <u>07-05-06</u> Signature <u>Diana C. Anderson</u> Typed or printed name <u>Diana C. Anderson</u>		Application Number 10/057,277	Filed January 25, 2002
		First Named Inventor Monty A. Forehand	
		Art Unit 2651	Examiner Kin Wong
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,794</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Mitchell K. McCarthy</u> Typed or printed name Mitchell K. McCarthy Telephone number <u>(405) 232-0621</u> Date <u>7/5/2006</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Dkt. P1598US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Monty A. Forehand
Assignee: SEAGATE TECHNOLOGY LLC
Application No.: 10/057,277 Group Art: 2651
Filed: January 25, 2002 Examiner: Kin Wong
For: FLY HEIGHT ADJUSTED SWEEP CYCLE FOR A DISC DRIVE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant is entitled to a patent unless the invention was patented or described.... 35 USC 102(b). This case is not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated the anticipatory rejections by any evidence in the record.

IT IS CLEAR ERROR THAT THE EXAMINER DID NOT EITHER ENTER THE AFTER-FINAL AMENDMENT OR STATE THE BASIS FOR NOT DOING SO


In the final rejection the Examiner objected to the language of claim 1 for indefiniteness. Claim 1 expressly recites a *raising* step and a *moving* step. The Examiner's basis for the objection was that the moving step is subsumed within the raising step; that is, according to the Examiner, is it moving while it is raising.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)

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Date: July 5, 2006


Signature

Diana C. Anderson
(type or print name of person certifying)

Applicant argued the claim language is clear on its face. That is, the raising step recites *raising a fly height of a read/write head to a maximum setting, and moving the read/write head while at the maximum fly height....* Clearly a plain reading of the claims concludes that the moving step doesn't begin until completion of the raising step. Nevertheless, Applicant amended claim 1 in order to obviate the Examiner's objection. This was the only claim amendment in Applicant's after-final response. However, the Examiner refused to enter the amendment because it "has not overcome the rejections." The Examiner provided no indication whatsoever in the Advisory action as to whether the objection is still standing, and if so then no reasoned statement was provided as to why Applicant's amendment did not obviate Examiner's objection. From the substance of the Advisory Action it appears the Examiner is unnecessarily preoccupied with and distracted by Applicant's previously broadening claim scope during prosecution.

Accordingly, this case is not in condition for appeal until this factual issue regarding the objection of claim 1 is resolved by the Examiner either withdrawing the objection or substantiating its basis in the record. Applicant prays the Panel will re-open the merits of this case for that purpose.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF ANTICIPATION BY FAILING TO PROVIDE EVIDENCE THAT THE CITED REFERENCES TEACH OR SUGGEST ALL THE RECITED FEATURES OF CLAIM 1

Applicant has argued in the record, without rebuttal by the Examiner, that the final rejection is based on a mischaracterization of a newly cited reference. (see Applicant's Response of 6/5/2006, ppg. 9-12) A mischaracterization of a cited reference does not form the basis for an appealable issue.

Claim 1 recites *raising a fly height of a read/write head to a maximum setting at a radial position; moving the read/write head radially while substantially at the maximum fly height to a beginning position....*

Newly cited Sasamoto '541 discloses moving the head radially across the disc during motor startup. That is, Sasamoto '541 moves the head across the disc in both radial directions during times when the head is contactingly engaging the disc and during times when the head is at a minimum fly height.

The Examiner mischaracterized the newly cited reference in stating: "Sasamoto '541

discloses a method in a disk drive for moving the read/write head at a maximum fly height in the beginning position and lowering the read/write head to a minimum fly height as the read/write head moves away from the beginning position.” (Office Action of 4/5/2006, pg. 2) The passage on which the Examiner relies (Sasamoto '451 col. 2 lines 28-42) discusses the curves in FIG. 3 to make the point that at the nominal disc speed a head contact will likely result in damage to the disc to the extent that stored data is lost. The passage does not in any way support the Examiner’s statement.

The Pre-Appeal Brief Panel must find in the underlying facts “substantial evidence” that adequately supports the Examiner’s legal conclusion of anticipation. This approach is consonant with the Office’s obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued that Sasamoto '451 fails in this regard, but the Examiner has only reticently maintained his position without any evidentiary basis whatsoever. This case is not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated the anticipatory rejection by any evidence in the record whatsoever, and that the basis provided is flawed because it is based on a mischaracterization of the cited reference.

This case is not ready for appeal until these legal and factual issues are resolved by the Examiner either withdrawing the rejection or substantiating it factually in the record. Applicant prays the Panel will re-open the merits of this case for that purpose.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF ANTICIPATION BY FAILING TO PROVIDE EVIDENCE THAT THE CITED REFERENCES TEACH OR SUGGEST ALL THE RECITED FEATURES OF CLAIM 9

Applicant has argued in the record, without rebuttal by the Examiner, that the final rejection is based on the Examiner failing to construe claim 9 properly as a means plus function claim, and based upon a mischaracterization of a newly cited reference. (see Applicant's Response of 6/5/2006, ppg. 12-14) A claim misconstruction and mischaracterization of a cited reference do not form the bases for appealable issues.

First, Applicant has pointed out in the record that claim 9 is in the form of a means plus function claim, reciting *steps for associating*, and that the Examiner is obliged as a matter of law to construe this steps-for element as the disclosed acts, and equivalents thereof, that are capable of the identical recited function. The Examiner's reticent refusal to do so is clearly reversible error.

Second, Claim 9 recites associating a spatial separation between the transducer and the storage medium in relation to a direction of moving the transducer across the storage medium. Applicant pointed out in the record that newly cited McNeil '311 discloses moving the head back and forth for several cycles at a constant fly height.

The Examiner mischaracterized the newly cited reference, implying it anticipates the claimed subject matter by broadly stating: "McNeil discloses a data storage device with a transducer and a storage medium along two dimensions with respect to each other in a data transfer relationship and control element that control [sic, controls] the execution of the move cycle routine that [sic] across the storage medium." (Office Action of 4/5/2006, pg. 3) In fact, the passage on which the Examiner relies (McNeil '311 Abstract) explicitly states that the head is swept forward and reverse at the same fly height. The passage does not in any way support the Examiner's statement.

The Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued that McNeil '311 fails in this regard, but the Examiner has only reticently maintained his position without any evidentiary basis whatsoever. This case is not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated the anticipatory rejection by any evidence in the record whatsoever, and that the basis provided is flawed because it is based on a mischaracterization of the cited reference.

This case is not ready for appeal until these legal and factual issues are resolved by the Examiner either withdrawing the rejection or substantiating it factually in the record. Applicant prays the Panel will re-open the merits of this case for that purpose.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF ANTICIPATION BY FAILING TO PROVIDE EVIDENCE THAT THE CITED REFERENCES TEACH OR SUGGEST ALL THE RECITED FEATURES OF CLAIM 18

Applicant has argued in the record, without rebuttal by the Examiner, that the final rejection is based upon a mischaracterization of a newly cited reference. (see **Applicant's Response of 6/5/2006, ppg. 15-16**) A mischaracterization of a cited reference does not form the basis for an appealable issue.

Claim 18 recites *spatially separate a transducer from a storage medium by a first separation...move the transducer...at the first separation...lower the transducer to a second separation...move the transducer across the storage medium at the second separation.*

Applicant pointed out in the record that newly cited McNeil '311 discloses moving the head back and forth for several cycles at a constant fly height. The Examiner's basis for the rejection of claim 18 was the same as for claim 9, which is based upon a mischaracterization of McNeil as discussed above.

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued that McNeil '311 fails in this regard, but the Examiner has only reticently maintained his position without any evidentiary basis whatsoever. This case is not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated the anticipatory rejection by any evidence in the record whatsoever, and that the basis provided is flawed because it is based on a mischaracterization of the cited reference.

This case is not ready for appeal until this factual issue is resolved by the Examiner either withdrawing the rejection or substantiating it factually in the record. Applicant prays the Panel will re-open the merits of this case for that purpose.

Respectfully submitted

By: 

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